

## REMARKS

### **A. Claim status**

Claims 5, 6, and 8-12 are rejected for the reasons stated below. Applicant has canceled claims 5, 6, 8, 9, and 12. Applicant has added new claim 13.

### **B. 35 U.S.C. § 112, first paragraph**

The examiner has rejected claims 5, 6, and 12 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. Applicant has canceled claims 5 and 6. The examiner contends that the term “water-impermeable, water-vapor permeable is not supported by the specification. Applicant respectfully disagrees. The specification states that the waterproof bootie of the present invention may be formed of material sold by W.L. Gore under the “Gore-Tex” trademark. [Specification, p. 3, line 18.] Applicant respectfully submits that this material is a water-impermeable, water-vapor permeable membrane. Notwithstanding this, applicant has substituted the term “waterproof” for the term “water-impermeable, water-vapor permeable” in claim 13, which otherwise includes all of the limitations of claim 12.

### **C. 35 U.S.C. § 103(a)**

Claims 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over international reference WO 92/14372 (“WO ‘372”) in view of U.S. Patent No. 3,805,419 to White (“White”). Applicant has canceled claim 8. Applicant traverses this ground for claim rejection as applied to claim 10 for the reasons stated below.

The examiner contends that WO ‘372 discloses all of the limitations of the claimed invention except for the insulating material being located but not compressed between the toe box and the lining and a lining of the cold insulating material having a surface secured to the

underside of the toe box. The examiner contends that White teaches an insulating layer 5 for a toe protected boot located, uncompressed, between the toe box 1 and a lining 6. The examiner has argued that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place an insulating layer between the toe box and the liner of WO '372 as taught by White to insulate the boot.

WO '372 discloses a boot having an removable protective insert. The insert includes a fabric backed foam layer 34 and, in some embodiments, a toe cap 27. Comparison of Fig. 3 (no toe cap) with Figs. 1, 2, and 4 (with toe caps) shows that a layer of foam having an uniform thickness is provided over an area corresponding to the top of a user's forefoot with this layer being compressed to a smaller thickness in the regions where the toe cap is present. The purpose of foam layer 34 also is said to be to "provide comfort to the wearer." [WO '372, p. 10, line 32.] The stated purpose of providing comfort suggests that contact between a wearer's foot and the foam layer 34 is contemplated during use, which would tend to compress the foam layer 34. The stated purpose also shows that the foam layer 34 does not provide a substantial thickness of compressible cold insulation material.

Applicants further disagree with the characterization of the WO '372 toe cap as being "oversized." WO '372 discloses a toe cap "having the shape of a portion of an egg" with the toe cap being "relatively high off the foot at the rear of the toe cap." [*Id.*, p. 5, lines 2-4.] The rear height of the toe cap "not only allows for objects to roll off the foot but enables the foot to bend fully without the upper rubbing against the top of the foot." [*Id.*, p. 5, lines 4-7.] Applicant respectfully submits that rear toe cap having a height sufficient to avoid the upper rubbing against the top of the foot is a standard feature of footwear provided with conventional toe caps.

While the WO '372 toe cap may have a particular shape, applicant finds nothing in this reference that teaches or suggests that the entirety of the toe cap is oversized. The cushioning function attributed to the foam layer 34 suggests that the toe cap is not sized so as to preclude contact with, and resultant compression of, the foam layer 34 during use.

White discloses an article of safety footwear with a cushioning layer 5 extending below toe cap 6. White teaches that a foam layer on the underside of the toe cap aids in the manufacture of a separate toe cap assembly that can be inserted into an essentially finished article.

Nothing in WO '372 or White teaches or suggests that the foam layer provides a cold insulating function. The foam layer of WO '372 is said to provide only a cushioning function; the foam layer of White is said to provide only cushioning and an aid in manufacturing of the toe cap assembly. The compression of the foam under the toe caps of WO '372 further shows that the cold insulating properties of the foam layer are not of interest. Nor does anything in White teach or suggest a foam layer having a cold insulating function.

The cushioning function of the foam layer of both WO '372 and White indicates that contact between a user's foot and the foam layer is expected (*e.g.*, because the foam is placed on the underside of a conventional, rather than an oversized, toe box). The expectation that a user's foot will contact the foam layer suggests that compression of the foam layer, and the corresponding loss of thermal insulating capability, is likely. Neither WO '372 nor White teaches or suggests a boot having a toe box sized to enclose a substantial thickness of compressible cold insulating material and the corresponding portion of a user's foot *without compression of the cold insulating material when the boot is worn*.

For the reasons stated above, the combination of WO '372 and White does not yield the claimed invention. Accordingly, applicant submits that claim 10 is allowable over the cited references.

Claims 11 and 12 are dependent on claim 10. Applicant submits that these claims also are allowable over the cited references at least for the reasons stated above with respect to claim 10.

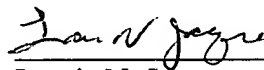
#### CONCLUSION

For the reasons stated above, the claims presented herein satisfy the statutory requirements of patentability and are patentable over the cited references. Applicants respectfully submit that the claims are in condition for allowance and request that a Notice of Allowance be issued.

Respectfully submitted,

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By:



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